

Appl. No. 09/833,847
Response Dated Nov. 4, 2003
Reply to Office Action of 8/4/03

Responses to Examiner's Remarks in Detailed Action

Reconsideration of the application is respectfully requested. The Application stands rejected under 35 USC § 103(a) as to all claims currently pending, on the basis of JP '573 in combination with various prior art references. Common to all rejections is the reliance upon JP '573. Based on the explanation below, Applicant respectfully requests that the Examiner withdraw the rejections.

Drawings

1. The Examiner acknowledges the proposal for drawing corrections, and maintains the objections previously levied until such drawings are supplied. Applicant encloses herewith corrective drawings. Applicant requests the opportunity to provide formal drawings later because (1) the drawing objection is based on elements in the claims, but the final version of the claims remains in flux, preventing Applicant from knowing the precise corrections required; and (2) in light of the foregoing, Applicant deems approval by the examiner prudent.

2. The Examiner requires showing of the "non-pendant electronically operable remote controlled system" of Claim 9. This element of the claims has been removed. Accordingly, Applicant believes the objection is moot, and the revision to the drawings is not necessary.

3. The Examiner requires showing of:

- a. the "plurality of spring loaded locking mechanisms" of claim 11;
- b. the "plurality of snap shackles" of claim 12; and
- c. the "safety cable" of claim 14.

Applicant includes in the Appendix its proposed additions of these elements to the drawings by the correction of Figure 3 and addition of a new Figure 4. Note that by amendment to Claim 11, a "plurality" of mechanisms need not be shown.

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§ 112 Issues

The Examiner objected to Claims 6 and 10 for antecedent basis reasons, and to Claim 9 for specification support reasons.

Claim 6 is amended to replace the phrase "it would be" with the phrase "the track is" in line 2, for which antecedent basis is found in Claim 1, part (a).

Claim 9 is amended to delete the "Non-pendant" terminology.

Claim 10 is amended at the suggestion of the Examiner to change "its second end" to "the second end". The phrase "said remote controlled system" is replaced with the phrase "an electronically operable remote controlled system".

Claim Rejections, § 103

The burden of showing a *prima facie* case of obviousness lies squarely on the Examiner.¹ "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness..." MPEP § 2141. The Examiner must show a number of elements in order to support such a case; among those are the following:

- Prior Art Must Support the Desirability of the Combination. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desireability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)." MPEP § 2143 (emphasis added).
- The Suggestion to Combine Must Be Specifically Identified. The Examiner must "explain where the motivation for the rejection is found, either in the references, or in the knowledge generally available to one in the art." MPEP 707.07, *Examiner Note*, Para. 7.37.04. See, e.g., In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998). In Rouffet, the Federal Circuit noted that to "prevent the use of hindsight based on the invention

¹ MPEP § 2141 provides: "The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process ... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." (emphasis by bold added)

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to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness."

Re: All Claims

The reference JP '573 serves as the basis (in combination with various other prior art references) for all rejections of claims 1 through 16. No rejection levied includes any alternative basis rendering reliance upon JP '573 unnecessary. Accordingly, by overcoming JP '573, applicant overcomes each rejection.

Claim 1 (and all dependent claims 2 through 14):

Applicant amends Claim 1 to include recitation of the relationship of the rod 17 to the vehicle upon which the payload rests. Specifically, Applicant's Claim 1 (and therefore all of its dependent claims) recites that the rod does not depend upon the vehicle for support. Support for this amendment is found at p. 5, lines 7 to 14 of the Specification, and Figure 2. As shown in the drawings, this positioning allows the payload and vehicle to pass under the rod.

In contrast to the limitation now in Applicant's claim, the rod shown in the figures relied upon by the examiner in JP '573 (# 25, in those figures), appears supported directly and solely by the vehicle itself.

With respect to each of the references combined with JP '573 by the examiner, it would not be obvious or even in the realm of consideration to those skilled in the art of overhead cranes, or like devices shown in the references cited by the examiner, to include such a bar. The addition of a rod in applications other than that claimed literally adds an extra hurdle over which the cargo of the crane (in this case, the covering) must pass. Adding such an additional hurdle is contrary to the traditional goals of skilled artisans, in that the skilled artisan will desire to reduce the height and distance the cargo must be lifted (thereby increasing the efficiency of the devices). Adding the rod increases both height

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and distance. The cited art (whether relied upon or not) is thus not appropriate for combination with JP '573, given that no source of motivation is cited by the examiner, and the modification is not desirable in those contexts.

Claims 4 through 8

The examiner cites the newly identified Casteel reference as a basis for combination with JP '573. As discussed above, even if this combination is appropriate, it fails to disclose the independence of the bar from the vehicle, as claimed in Claim 1 and its progeny.

Moreover, Casteel is not appropriate art for combination with JP '573 or even for use in this application. A reference may not serve as a basis for a § 103 rejection for obviousness where the modification or combination made to the reference destroys the intended function of the invention found in that reference. See, e.g., In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Casteel is intended for use with rigid structures in which vertical and horizontal orientation are critical. As discussed in Casteel, that device allows for assembly of a structure in a horizontal position, followed by later pivoting into the vertical. This operation has no application to the present invention. Combination is appropriate only where an advantage is realized by the combination, else there is no motivation to combine. Here, the imminently flexible tarpaulin would not change its vertical/horizontal orientation when the Casteel device pivots (i.e., the tarpaulin would continue to adopt a plumb-line orientation when lifted).

Claims 9-10, 11-12, and 13-14.

As noted in general, above, JP '573 does not include the limitation of a rod being supported other than by the vehicle. The examiner's combination with art cited in these rejections focuses only on adding the limitations found in the dependent claims. The combined art does not show any motivation to include a rod 17 that is free from the vehicle. Accordingly, even in combination, JP '573 and the cited references fail to teach all limitations of the claims. The rejections therefore should be withdrawn.

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New Claims 17-19

Applicant has added Claims 17 and 18, which each depend directly from Claim 1, and respectively add limitations regarding height of the rod (claim 17) and its vertical disposition between the track and the vehicle. In combination with the elements in Claim 1, neither is believed to be taught by the prior art.

Applicant further adds Claim 19, a method claim, describing the method of covering payloads taught by the Specification's disclosure. It is likewise believed to be new and novel over the prior art.

Fees

This response is timely and no fees or extensions are required.

Applicant has diligently sought to comply with all requirements and to correct all informalities and objections. The Application is believed to be in condition for allowance, and a timely Notice of Allowance is respectfully requested.

Respectfully submitted,
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Date

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ATTACHMENTS